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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,303	06/19/2001	Garry D. Gladstone	GLADS-001A	4813
7663	7590	03/14/2006	EXAMINER	
STETINA BRUNDA GARRED & BRUCKER			COLBERT, ELLA	
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ALISO VIEJO, CA 92656			PAPER NUMBER	
			3624	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/884,303	Applicant(s) GLADSTONE, GARRY D.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-7 and 10-27 are pending in this communication filed 12/30/05 entered as Response After Non-Final Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 and 10-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,454,104) Steidlmayer et al, hereafter Steidlmayer in view of (US 6,477,647) Venkatraman et al, hereafter Venkatraman.

Claim 1. Steidlmayer teaches, An automated method of communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution, the method comprising the steps of: (a) receiving, through the use of a computer, trade trigger criteria for use by market analysis software, the market analysis software being configured to electrically receive market data, the trade trigger criteria being related to the market data (col. 4, lines 5-37 and fig. 2 (141)); (b) accessing, through the use of a computer, the market analysis software to analyze the market data and generate a trade decision in response to the trade trigger criteria being met by changes in the market data, the market data being independent of the trade decision (col. 9, lines 50-col. 10, line 20, fig. 2 (141)). Steidlmayer failed to teach, (c)

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automatically communicating, through the use of a computer, a trade order based upon the trade decision to the marketplace via the on-line trading account. Venkatraman teaches, automatically communicating, through the use of a computer, a trade order based upon the trade decision to the marketplace via the on-line trading account (col. 10, lines 13-29, fig. 2 (24), and fig. 7 (120). It would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically communicate through the use of a computer, a trade order based upon the trade decision to the marketplace via the on-line trading account and to modify in Steidlmayer because such a modification would allow Steidlmayer to receive a response through the computer and to execute the response according to the trade decision.

Claim 2. Steidlmayer failed to teach, The method of Claim 1 wherein the market analysis software is hosted by an entity different than the financial institution. Venkatraman teaches, The method of Claim 1 wherein the market analysis software is hosted by an entity different than the financial institution (col. 5, lines 30-41 and col. 9, lines 12-18). Steidlmayer disclosed the market analysis software as discussed above in claim 1. Venkatraman disclosed the entity being different than the financial institution. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the market analysis software is hosted by an entity different than the financial institution and to modify in Steidlmayer in view of Steidlmayer's teachings of marketing analysis software and because such a modification would allow Steidlmayer to have the capability to send an e-mail from one entity to another regarding the analysis.

Claim 3. Steidlmayer failed to teach, The method of Claim 1 wherein the on-line trading account is hosted at a web address accessible through a computer network. Venkatraman teaches, The method of Claim 1 wherein the on-line trading account is hosted at a web address accessible through a computer network (col. 1, lines 54-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the online trading account hosted at a web address accessible through a computer network and to modify in Steidlmayer because such a modification would allow Steidlmayer to have an Internet where a customer can connect with any available method and visit the OTC web page (URL) and trade.

Claim 4. Steidlmayer failed to teach, The method of Claim 1 wherein the market analysis software is hosted at a web address accessible through a computer network. Venkatraman teaches, The method of Claim 1 wherein the market analysis software is hosted at a web address accessible through a computer network (col. 9, lines 3-11, fig. 4, fig. 6, and fig. 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the market analysis software hosted at a web address accessible through a computer network and to modify in Steidlmayer because such a modification would allow Steidlmayer to have an Internet where a customer can connect with any available method and visit the OTC web page (URL) and trade.

Claim 5. Steidlmayer teaches, The method of Claim 4 wherein step (b) includes communicating the trade trigger criteria to the market analysis software via a computer network (col. 4, lines 14-26).

Claim 6. Steidlmayer teaches, The method of Claim 1 wherein the market analysis software is hosted at a personal computer (col. 3, lines 45-67 and col. 6, lines 56-58).

Claim 7. Steidlmayer teaches, The method of Claim 1 wherein the trade trigger criteria is based upon a status of the on-line trading account (col. 4, lines 14-22).

Claim 10. This independent claim is rejected for the similar rationale as above for claim 1.

Claim 11. This dependent claim is rejected for the similar rationale as given above for claim 3.

Claim 12. This dependent claim is rejected for the similar rationale as given above for claim 2.

Claim 13. This dependent claim has a step that corresponds to claim 4 above and is rejected for the similar rationale as given above for claim 4.

Claim 14. This dependent claim has a step that corresponds to claim 5 above and is rejected for the similar rationale as given above for claim 5.

Claim 15. This dependent claim has a step that corresponds to claim 6 above and is rejected for the similar rationale as given above for claim 6.

Claim 16. This dependent claim has a step that corresponds to claim 5 above and is rejected for the similar rationale as given above for claim 5.

Claim 17. Steidlmayer teaches, The system of Claim 10 wherein the market analysis software includes multiple market analysis software, each having a different analysis algorithm associated therewith (col. 12, line 25-col. 14, line 19).

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Claim 18. This dependent claim is rejected for the similar rationale as given above for claim 7.

Claim 19. This independent claim is rejected for the similar rationale as given above for claim 7, 10, 16, and 18.

Claim 20. This dependent claim is rejected for the similar rationale as given above for claim 11.

Claim 21. This dependent claim is rejected for the similar rationale as given above for claim 12.

Claim 22. This dependent claim is rejected for the similar rationale as given above for claim 21

Claim 23. This dependent claim is rejected for the similar rationale as given above for claim 13

Claim 24. This dependent claim is rejected for the similar rationale as given above for claim 17.

Claim 25. This dependent claim is rejected for the similar rationale as given above for claim 16.

Claim 26. This dependent claim is rejected for the similar rationale as given above for claim 14.

Claim 27. This dependent claim is rejected for the similar rationale as given above for claim 18.

Response to Arguments

4. Applicant's arguments filed 12/30/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Establishing *prima facie* obviousness requires a showing that the skilled artisan, confronted with the same problems as the Inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art has been considered but is not considered persuasive. Response: See MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

In response to applicant's further argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Issue no. 2: Applicant argues: The Office Action fails to establish a prima facie case of obviousness because the references do not teach an automated method of communicating trade orders to a marketplace of financial instruments through an on-line trading account with a financial institution and the Examiner has merely utilized the Applicant's disclosure as a roadmap to attempt to establish a case of obviousness. This is the exact "hindsight" type of reasoning that the Federal Circuit has sought to avoid has been considered but is not persuasive. Response: The response to the hindsight argument has been addressed above in Issue no. 1. The Examiner took part of the wording from the cited column and lines of the reference and interpreted them to read on the motivation given. Nothing was taken from Applicant's disclosure as the motivation.

Issue no. 3: Applicant argues: The Steidlmayer et al and Venkatraman et al. references are silent with respect to the aspect of Applicant's invention that relates to an automated method of communicating trade orders to a marketplace and neither Steidlmayer et al. nor Venkatraman et al. teach or suggest "an automated method of communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution as required by independent claims 1, 10,

and 19 has been considered but is not persuasive. Response: In response to applicant's arguments, the recitation "an automated method of communicating trade orders to a marketplace for financial instruments through an on-line trading account with a financial institution" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Issue no. 3: Applicant argues: It is improper to combine the Steidlmayer et al reference with the Venkatraman et al reference because the stated purpose of the invention disclosed by the Steidlmayer et al reference would be defeated by the suggested combination and combining the Steidlmayer et al reference with making an automatic communication using a computer would defeat the purpose of a user visually studying the display to make a calculated trade decision. Applicant's invention as recited in Claim 1 includes receiving through the use of a computer, trade trigger criteria for use by market analysis software, the market analysis software being configured to electrically receive market data" has been considered but is not persuasive. Response: It is unclear how the market analysis software can analyze the market data and then generate a trade decision based on that analysis without input from some place.

Software is defined as computer programs, procedures, and possibly associated documentation and data pertaining to the operation of a computer system.

Issue no. 4: Applicant argues: Applicant's invention contemplates transmitting a trade order without requiring the user to be present has been considered but is not persuasive. Response: There is nothing in Applicant's claim limitations that claim transmitting a trade order without requiring the user to be present.

Issue no. 5: Applicant argues: there is no need for a person to analyze data on a visual display because a trade decision is made without requiring analysis by a user and because the user/trader is not required to enter a trade order by manually typing and/or computer mouse clicks to transmit the desired trade with the system configured to make a trade decision when a trade trigger criteria is met has been considered but is not persuasive. Response: The claim limitation in claim 1 (b) recites "accessing, through the use of a computer, the market analysis software" which is interpreted as the user accessing the computer and "(c) automatically communicating through the use of a computer a trade order" is interpreted as the user automatically communicating through the use of a computer a trade order". The claim limitations do not clarify that the user/trader is not required to enter the trade order by manually typing and/or computer mouse clicks to transmit the desired trade with the system configured to make a trade decision when a trade trigger criteria is met allowing trade orders to be transmitted to the marketplace for execution and avoid time delays between the trade decisions and the trade execution due to trader inattention or absence.

Conclusion: The Examiner carefully drew up a correspondence of each of Applicants' claimed limitations, one or more referenced passages in Steidlmayer and Venkatraman, what is well known in the art and what is obvious to one having ordinary skill in the art at the time the invention was made.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

It is respectfully requested Applicant point out to the Examiner the inventive concept in the claim limitations of claims 1, 10, and 19 and to particularly and distinctly claim that which the Applicant claims to be the inventive concept in the claim language.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Examiner
February 27, 2006